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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/525,274	04/07/2005	James John Schmitt	ACA6276P1US	4986	
	7590 06/29/2007		EXAM	IINER	
Ralph J Mancini Akzo Nobel Inc			MCNELIS, K	MCNELIS, KATHLEEN A	
Intellectual Prop 7 Livingstone A	perty Department Evenue	•	ART UNIT	PAPER NUMBER	
Dobbs Ferry, NY 10522-3408			1742		
			MAIL DATE	DELIVERY MODE	
•	•		06/29/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief Exam

Application No.	Applicant(s)	
10/525,274	SCHMITT ET AL.	
Examiner	Art Unit	
Kathleen A. McNelis	1742	

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The MAILING DATE of this communication appe	ars on the cover sheet with the c	orrespondence add	ress
THE REPLY FILED <u>06/15/2007</u> FAILS TO PLACE THIS APPLI	CATION IN CONDITION FOR ALL	OWANCE.	
1. The reply was filed after a final rejection, but prior to or on this application, applicant must timely file one of the follow places the application in condition for allowance; (2) a No a Request for Continued Examination (RCE) in compliant time periods:	ving replies: (1) an amendment, aff tice of Appeal (with appeal fee) in (idavit, or other evider compliance with 37 C	nce, which FR 41.31; or (3)
a) \square The period for reply expires $\underline{5}$ months from the mailing date			
b) The period for reply expires on: (1) the mailing date of this A no event, however, will the statutory period for reply expire I Examiner Note: If box 1 is checked, check either box (a) or	ater than SIX MONTHS from the mailing (b). ONLY CHECK BOX (b) WHEN THE	g date of the final rejecti	on.
TWO MONTHS OF THE FINAL REJECTION. See MPEP 7 Extensions of time may be obtained under 37 CFR 1.136(a). The date	• •	36(a) and the appropria	te extension fee
have been filed is the date for purposes of determining the period of ex under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the set forth in (b) above, if checked. Any reply received by the Office late may reduce any earned patent term adjustment. See 37 CFR 1.704(b) NOTICE OF APPEAL	tension and the corresponding amount shortened statutory period for reply orig r than three months after the mailing da	of the fee. The approprinally set in the final Offi	iate extension fee ce action; or (2) as
2. ☐ The Notice of Appeal was filed on 15 June 2007. A brief	in compliance with 37 CFR 41.37 r	nust be filed within tw	o months of the
date of filing the Notice of Appeal (37 CFR 41.37(a)), or a appeal. Since a Notice of Appeal has been filed, any repl AMENDMENTS	ny extension thereof (37 CFR 41.3	7(e)), to avoid dismis-	sal of the
3. The proposed amendment(s) filed after a final rejection,			ecause
(a) They raise new issues that would require further co		TE below);	
 (b) They raise the issue of new matter (see NOTE below) (c) They are not deemed to place the application in be appeal; and/or 		ducing or simplifying	the issues for
(d) They present additional claims without canceling a	corresponding number of finally rej	ected claims.	
NOTE: See Continuation Sheet. (See 37 CFR 1.1	16 and 41.33(a)).		
4. The amendments are not in compliance with 37 CFR 1.1		mpliant Amendment	(PTOL-324).
5. Applicant's reply has overcome the following rejection(s)			
6. Newly proposed or amended claim(s) would be a non-allowable claim(s).	,	•	
7. For purposes of appeal, the proposed amendment(s): a) how the new or amended claims would be rejected is pro The status of the claim(s) is (or will be) as follows: Claim(s) allowed:		II be entered and an e	explanation of
Claim(s) objected to:			•
Claim(s) rejected: <u>1-7,10 and 11</u> . Claim(s) withdrawn from consideration: <u>8 and 9</u> .			
AFFIDAVIT OR OTHER EVIDENCE 8. ☐ The affidavit or other evidence filed after a final action, but because applicant failed to provide a showing of good an was not earlier presented. See 37 CFR 1.116(e).			
9. The affidavit or other evidence filed after the date of filing entered because the affidavit or other evidence failed to showing a good and sufficient reasons why it is necessar	overcome <u>all</u> rejections under appe y and was not earlier presented. S	al and/or appellant fa ee 37 CFR 41.33(d)(ils to provide a 1).
10. ☐ The affidavit or other evidence is entered. An explanation REQUEST FOR RECONSIDERATION/OTHER	n of the status of the claims after e	ntry is below or attacl	ned.
 The request for reconsideration has been considered by See Continuation Sheet. 	·,	n condition for allowa	nce because:
12. ☐ Note the attached Information Disclosure Statement(s).13. ☐ Other:	(PTO/SB/08) Paper No(s)		

U.S. Patent and Trademark Office PTOL-303 (Rev. 08-06)

Application No. 10/525,274

Continuation of 3. NOTE: The following amendments change the scope of the finally rejected claims and will therefore require additional consideration and/or search:

- 1) the deletion of calcium fluoride as an additive in claims 1 and 11.
- 2) the amended limitation to claim 5 changing "a cellulose ether" to "carboxymethyl cellulose", and
- 3) the change of dependency of claim 7.

Continuation of 11, does NOT place the application in condition for allowance because:

1) Applicant argues that the 01/18/2007 Office action was not properly made final because new rejection grounds were applied due to amended limitations to the claims. The new grounds were improperly applied to claims 3, 4 and 6 which were NOT amended and M.P.E.P 706.07(a) states that a rejection will not be made final if it includes a rejection on newly cited art of any calim not amended by applicant or owner in spite of the fact that other claims may have been amended to require newly cited art.

Examiner's response is that claims 3, 6 and 6 depend from amended claim(s).

2) Applicant affirms the election of sodium borate in calims 1-7, 10 and 11 for prosecution on the mertis with traverse.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

- 3) Arguments related to the rejection of claims 1, 2 and 4 under 35 U.S.C. 103(a) over CN '218 are based on amended claim limitations which change the scope of claim 1 from the finally rejected claims and will therefore require additional consideration and/or search.
- 4) Arguments regarding the rejection of claim 3 as unpatnetable over CN '218 in view of Morris are based on amended claim limitations which change the scope of claim 1 from the finally rejected claims and will therefore require additional consideration and/or search. See also p. 11 of 01/18/2007 Office action, response to argument 3.
- 5) Arguments regarding rejections of claims 5-7, 10 and 11 under 35 U.S.C. 103(a) over CN '218 are based on amended claim limitations which change the scope of claim 1 from the finally rejected claims and will therefore require additional consideration and/or search.
- 6) Regarding the rejection of claims 1-7 and 11 under 35 U.S.C. 103(a) over CN '218 in view of SU '867 or Stewart et al. or Lewis et al., SU '867 is non-analogous to CN '218 since SU '867 applies a coating to a different type of pellet (Fuel flux ore) whereas CN '218 is an agglomeration process. Stewart relates to a flux in a benefication process which is irrelevant to the claimed agglomeration process. Lewis is unrelated to an agglomeration process.

Examiner's response is that SU '687 discloses consolidating a pellet containing fuel, flux and ore and is analagous since CN '218 also discloses consolidation of flux and ore. SU '687 teaches that both borax and boroic acid are both used as water soluble B-containing substances, and are therefore substitutes in a consolidation process. Stewart et al. discloses that the flux comprising either boric acid or borax is benefical during the heating and reduction of ore, therefore boric acid or borox are substitutes in an ore heating process. The pellets of CN '218 are used for steelmaking, and Lewis et al. teaches that boric acid and borax are substitutes in a steelmaking process.

7) Regarding the rejection of claims 1-7 and 11 under 35 U.S.C 103(a) over Banyai et al., sodium tetraborate is mentioned in 3-12 as a comparaitive example. Since other binders had superior results, Banyai teaches against the use of sodium tetraborate and does not render the invention obvious.

Examiner's response is that Banyai et al. dicloses the claimed invention as discussed p. 8 of the 01/18/2007 Office action. Examiner does not find any statement in Banyai et al. that the composition in sample 3-12 is clearly inferior and should not be used, nor does the fact that some of the other compositions had superior wet drop numbers or wet or dry compressive strengths change the fact that the composition is disclosed in the prior art.

8) Regarding the rejection of claim 10 under 35 U.S.C. 103(a) over CN '218 in view of SU '867 or Stewart et al. or Lewis et al, and JP '243, Ceramics Monthly and digitalfire.com, the fact that borax, colemenite or ulexite may be equivalents in the process for modifying slag (JP '243) in ceramic bodies (Ceramics monthly) or in making pottery (digitalfire.com) does not mean that such compounds would perfom the same in the claimed agglomeration process.

Examiner's response is that the use of the pellets of CN '218 is as raw material in steelmaking, specifically to smelt iron (abstract). JP '243 teaches that borax, colemenite or ulexite are substitutes in smelting iron ores. Digitialfire.com teaches Gillespie Borate was developed to match the chemical composition of Gerstley borate, and that Gerstley borate contained a lot of Ulexite, therefore the properties are similar. Ceramics Monthly discloses that the compositions of Gerstley, Laguna, Murray's and Gillespie borates are similar. Since digitalfire.com and Ceramics monthly teach that the substitute materials have the same or similar compositions, the same or similar properties would be expected regardless of the application.

06/26/2007

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